REMARKS/ARGUMENTS

Pending claims 31-37, 39-41, 43-51, 53, and 55-63 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,324,644 (Rakavy) in view of U.S. Patent No. 6,161,177 (Anderson), and U.S. Patent No. 6,202,091 (Godse), and in further view of U.S. Patent No. 5,483,649 (Kuznetsov). Applicant respectfully traverses the rejections.

The Examiner fails to provide any legally proper motivation to combine the references. Instead, the Examiner engages in the hindsight-based obviousness analysis that has been widely and soundly disfavored by the Federal Circuit. In order to prevent a hindsight-based obviousness analysis, the Federal Circuit requires that "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316-17 (Fed Cir. 2000). No such showing is present here. In this regard, there is no motivation to combine Rakavy, which is directed to a network enhanced BIOS system, with Anderson, which is directed to a method for detecting or reprogramming BIOS. This is so, as nowhere does Anderson relate in any way to the network-type issues addressed in Rakavy. Furthermore, there is no motivation to further combine these references with Kuznetsov, which is directed to a hardware protection mechanism. Nor does the Office Action anywhere indicate the manner in which the hardware protection mechanism of Kuznetsov must be modified to be used in connection with the other references. Finally, there is no motivation to further combine these references with Godse as proposed by the Examiner. The Examiner argues Godse teaches or suggests "selectively load the bios based on the system state indicating a connection to the network." (Office Action, pp. 7, 16). However, Godse is merely directed to a pointer that can be "selectively set to point toward a local site or remote site." *Id.* Godse makes no suggestion regarding selectively loading BIOS modules based on a state indicative of a "connection to a network." In other words, there is no suggestion or teaching of the desirability of making the specific combination that was made by the applicant. For at least these reasons, the claims are allowable over the references.

Claims 31, 40, and 51 are rejected under 35 U.S.C. §103. To establish *prima facie* obviousness, each claim element must be taught or suggested by the prior art. M.P.E.P. 2143.03. Claims 31 and 40 both recite requesting different levels of authentication information based on "system state" indicative of whether a "system is connected to a network." Claim 51 recites a

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processor to load a first or second BIOS based on a state indicative of a "connection to a network." The Examiner concedes that neither Rakavy, nor Anderson or Godse, teach or suggest this claim element. Instead, the Examiner relies on Kuznetsov to address this element. (Office Action, p. 4). However, Kuznetsov only "identifies the personal computer user" (9:33-37) and then the "the protection initialization program requests the personal computer user password." (9:55-63). Thus, Kuznetsov (i) identifies the user and (ii) asks for a password. At no time does Kuznetsov teach or suggest requesting different levels of authentication information based on "system state" indicative of whether a "system is connected to a network." Nor does the Kuznetsov teach or suggest loading different BIOS programs based on a state indicative of a "connection to a network." Thus, for at least these reasons claims 31, 40, and 51, and their dependent claims, are allowable over the cited references.

Claims 31, 40, and 51 are further allowable over the cited references for at least the following reason. Claims 31, 40, and 51 recite loading a first or second BIOS based on a "system state" indicative of whether a system is connected to a network. The Examiner relies on Gotse to address this element. (Office Action, p. 3). However, Gotse is merely directed to a pointer that can be "selectively set to point toward a local site or remote site." *Id.* Godse makes no suggestion regarding selectively loading BIOS modules based on a state indicative of a "connection to a network." Thus, for at least these reasons claims 31, 40, and 51, and their dependent claims, are allowable over the cited references.

Claim 51 is further allowable over the cited references for at least the following reason. Claim 51 discloses a first BIOS module "stored in a first storage of the system" and a second BIOS module "stored in a second storage of the system." The Office Action relies on Anderson for such a teaching. (Office Action, p. 11). Anderson, however, discusses a CPU that executes a BIOS stored in an EEPROM. (4: 55-60). If the CPU cannot execute that BIOS, a BIOS program stored on a floppy disk is accessed. However, this floppy disk is not "of the system." According to the Office Action, a BIOS stored on a floppy disk in Zimbabwe would be deemed "of the system" for a computer having a different BIOS that is located in the United States. This logic goes too far. For at least these reasons, claim 51 and its dependent claims are allowable over the cited references.

Claims 53 and 58 are also rejected under 35 U.S.C. §103. To establish *prima facie* obviousness, each claim element must be taught or suggested by the prior art. M.P.E.P. 2143.03.

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Claim 53 recites a third BIOS module stored in a "third storage." Claim 58 recites a fourth BIOS module stored in a "fourth storage." In contrast, Anderson recites several BIOS programs in a single EEPROM. (5:22-23). In other words, Anderson has several BIOS in a first storage—not a "third storage" or a "fourth storage." For at least these reasons, claims 53 and 58, and their dependent claims, are allowable over the cited references.

Claims 59, 60, and 62 are rejected under 35 U.S.C. §103. To establish *prima facie* obviousness, each claim element must be taught or suggested by the prior art. M.P.E.P. 2143.03. Claims 59 and 60 depend from claim 58. Claim 58 recites a fourth BIOS module stored in a fourth storage. Claim 59 states a "card comprises a fourth storage" and claim 60 states a "fourth storage comprises a smart card." Claim 62 states the "authentication information [that] includes presence of a smart card." The Office Action relies on Rakavy for such a teaching. (Office Action, p. 14). In contrast, Rakavy merely discloses an automated teller machine. (5:42-44). Unlike claims 59 and 60, Rakavy does not teach or suggest a fourth BIOS module stored in a fourth storage—much less a fourth storage that comprises a card. Unlike claim 62, Rakavy fails to even discuss smart cards—much less "authentication information [that] includes presence of a smart card." For these reasons, claims 59, 60, and 62 are allowable over the cited references.

Claim 57 is also rejected under 35 U.S.C. §103. To establish *prima facie* obviousness, each claim element must be taught or suggested by the prior art. M.P.E.P. 2143.03. Claim 57 recites requesting a "first level of authentication information if the system is connected to the network." The cited reference, Kuznetsov, fails to even address a network. For at least these reasons, claim 57 is allowable over the cited reference.

Claim 61 is rejected under 35 U.S.C. §103. To establish *prima facie* obviousness, each claim element must be taught or suggested by the prior art. M.P.E.P. 2143.03. Claim 61 recites executing a loaded BIOS to "request the authentication information from the user and authenticate the user." The Examiner fails to show how Kuznetsov uses a loaded BIOS module "to request the authentication information from the user and authenticate the user." In fact, Kuznetsov states that the "protection initialization program requests the personal computer user password"—not the BIOS. (9:55-60). Simply put, Kuznetsov does not teach or suggest performing authentication via a BIOS. For at least these reasons, claim 61 and its dependent claims are allowable over the cited references.

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Claim 63 is rejected under 35 U.S.C. §103. To establish *prima facie* obviousness, each claim element must be taught or suggested by the prior art. M.P.E.P. 2143.03. Claim 63 states "authenticating the user ... after an operating system is loaded." The portions of the references cited in the Office Action fail to address whether any authentication occurs "after an operating system is loaded." For at least these reasons, claim 63 is allowable over the cited references.

In view of these remarks, the application is now in condition for allowance and the Examiner's prompt action in accordance therewith is respectfully requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504.

Respectfully submitted,

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